REMARKS

INTRODUCTION

Claims 1-33 were previously pending.

Claim 34 has been added.

Claims 1-34 are now pending and under consideration.

Claims 1-33 stand rejected.

Claims 1, 10, 20-22, 24-27, 29, 31 and 33 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

In view of the number of issues raised below by the Applicant, it is respectfully noted that an Examiner is required to answer and address all of an Applicant's traversals. See at least MPEP § 707.08(f). This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection.

Finally, regarding the following arguments concerning the prior art rejections, even if new grounds of rejection are found, "[t]he examiner must, however, address any arguments presented by the applicant which are still relevant to any references being applied" (MPEP § 707.07(f)). Applicant respectfully requests a response to each of the following arguments that may remain relevant without regard to the particular references cited.

REJECTIONS UNDER 35 USC § 103

In the Office Action, at pages 3-16, claims 1-8, 11-17 and 20-33 were rejected under 35 U.S.C. § 103 as being unpatentable over Mclaughlin in view of Stokes. This rejection is traversed and reconsideration is requested.

CLAIMS 1, 18, 20, PRIOR ART COMBINATION DOES NOT RELATE TO A USER OR USER
INPUT CATEGORIZING A COLOR

Amended claim 1, for example, recites "receiving interactive user input with which a user
categorizes [into a color perception category] the color displayed". Claim 18 recites "a user
categorizes the color displayed by interactively selecting one of the monochrome patches
displayed with a color of the specified color name of a color perception category". Claims 20-22
recite "allowing a user to categorize the displayed color by indicating which of the color
perception categories the displayed color of the color chart signal is perceived to belong in".
Claims 24 and 25 recite "categorizing the displayed color by interactively indicating a perceived
color perception category of the displayed color". Claim 26 recites "allow[ing] a user to
categorize the displayed color by interactively indicating a perceived color perception category of
the displayed color". Claims 27 and 29 recite "receiving [interactive, claim 27] input that
categorizes the displayed color". Claim 31 recites "categorizing the displayed color by
interactively identifying or indicating a perceived color perception category of a color emitted by a
display system". Claim 33 recites "interactively categorizing predetermined color values by
identifying perceived color perception categories of the predetermined color values when
displayed by the display system".

The Merriam Webster Online Dictionary indicates that "categorize" can indicate "to put
into a category: CLASSIFY".

In contrast, McLaughlin discloses a user selecting a precise color. In the Interview
Summary of January 8, 2004, the Examiner's Supervisor stated that McLaughlin teaches
"precise color selection". The rejection cites Figure 5 of McLaughlin. Figure 5 shows an
interface to enter "a desired numerical value" or manipulate controls to set a "level" of brightness
or contrast (see col. 8, line 61 to col. 9, line 24). Precise "levels" and "numerical values" are not
the same as color perception categories. The interface in Figure 5 in no way allows a
categorization of a displayed color.

The rejection also referred to Figure 6 of McLaughlin. Figure 6 "allow[s] a user to alter
one primary color" (col. 10, lines 56-59). The user enters a desired "white point" by entering
particular "values" of red, green, and blue (col. 11, lines 8-14). Again, a color "point" and a tri-
color "value" are specific and are not the same as categorizing a color into a color perception

category.

The rejection finally referred to Figure 11 of McLaughlin, however Figure 11 does not add anything beyond Figures 5 and 6. Figure 11 only shows an application of the same interfaces of Figures 5 and 6 (see col. 15, lines 16-18; and col. 15, lines 21-23).

In sum, the claims mentioned above relate to user or interactive categorization of a displayed color (or user input for the same), and using the same to profile or characterize a display displaying the color. McLaughlin only specifies a particular or precise value, which is not a category. And, as acknowledged by the Examiner (page 4, last line) Stokes does not receive user input or even display anything; Stokes is simply an algorithm for computing a color gamut map.

Applicant respectfully requests the Examiner to point out where in the prior art a user is able to categorize or specify a color perception category of a color or where user input for the same occurs.

Withdrawal of the rejection is respectfully requested.

PRIOR ART COMBINATION IS IMPROPER: REFERENCES TEACH AWAY FROM THEIR COMBINATION

As stated in MPEP § 2143.03, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." As discussed above, McLaughlin specifically requires a user to input specific numeric values, levels, etc. For example, the user-entered white point is a particular color "when the computer causes emission of maxiumum values of red, blue and green light" (col. 1, lines 48-50). The entire specification of McLaughlin refers to user inputted "values" and parameter "values". According to the Merriam Webster Online Dictionary, a value is "a numerical quantity that is assigned or is determined by calculation or measurement <let x take on positive values> <a value for the age of the earth> b : precise signification <value of a word>". This is also the mutual understanding of McLaughlin agreed to at the Interview.

The rejection proposes modifying McLaughlin such that the user inputs a color perception category rather than a particular value. Allowing a user to input a color category

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containing a substantial number of colors, in McLaughlin would defeat McLaughlin's intended purposes of matching a printed color with any particular displayed color, providing precise color calibration, and allowing a user to set a display parameter "value". None of these would be possible in McLaughlin if a user were to input a general color perception category that does not identify a precise color value.

PRIMA FACIE CASE OF OBVIOUSNESS NOT MET: MOTIVE NOT FOUND IN PRIOR ART

The rejection did not provide a <u>motive in the prior art</u> for combining or modifying McLaughlin with Stokes. MPEP § 2144.08 states that the Examiner is to:

> "make express fact-findings relating to the Graham factors,
> focusing primarily on the prior art teachings discussed above. The
> fact-findings should specifically articulate <u>what teachings or
> suggestions **in the prior art**</u> would have motivated one of ordinary
> skill in the art..."

The rejection does not provide any prior art of record indicating why one skilled in the art would be motivated to make the combination. For example, there is no citation indicating a pre-combination desirability of the combination, or an expectation of some advantage before the combination is made, or even what problem needs to be solved.

The Examiner is respectfully requested to withdraw the rejection or provide a motive <u>in the prior art</u> that would indicate the desirability of the proposed combination before the combination has been made.

CLAIM 5

The rejection of claim 5 is inconsistent with the rejection of claim 1. The rejection of claim 1 states that McLaughlin does not disclose color perception categories. Stokes was not cited in rejecting claim 5. Therefore, it is impossible for a parameter to be in one of two adjacent "color perception areas". Withdrawal of the rejection is respectfully requested.

CLAIM 6

The rejection of claim 6 is improper because again McLaughlin is modified without any motivation provided from the prior art. "Rejection ... for obviousness under ... §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." In re Lee 61 USPQ2d 1430 (CA FC 2002). The rejection relies on no evidence of record.

The rejection is also traversed because the modification would render McLaughlin unfit for its intended purpose. As discussed above, McLaughlin requires a user to input a precise numeric value, either textually or graphically. In order to operate with names, McLaughlin would need millions of different names to represent each selectable different specific color. This would be impossible. How would one name hundreds or even thousands of small gradations of gray-blue, for example?

Withdrawal of the rejection is respectfully requested.

CLAIMS 7 AND 8

Claim 7 recites "said input unit enters a name of a color of each of a plurality of monochrome figures". Claim 8 also recites a color name. Claims 7 and 8 were rejected without reference to Stokes. However, as explicitly stated in the rejection of claim 6, "Mclaughlin et al. do not disclose entering a name of a color..."

Withdrawal of the rejection of claims 7 and 8 is respectfully requested.

CLAIMS 15-17 RECITE FEATURES REJECTED WITHOUT SUPPORT OR REFERENCE TO PRIOR ART

In item 19 of the Office Action, the rejection stated that claims 1 and 15 are "similar in scope and [therefore] rejected under the same rationale". Claim 1 does not recite claim 15's

"outputting to said display a color chart signal indicating a color value of a monochrome figure and color name signals, which are representative of a plurality of color names corresponding to the color value, respectively". This feature of Claim 15 has not been examined.

Claim 15 does not recite claim 16's "color values in adjacent color perception areas on a chromaticity diagram". Therefore, this feature of claim 16 has been rejected without any explanation or citation to prior art.

Claim 17 was rejected only as similar to claims 15/16, however, these claims do not recite claim 17's "series of colors in adjacent areas for two sorts of colors adjacent to one another on a chromaticity diagram are display". Claim 17 has not been fully examined.

Due to incomplete examination, withdrawal of the rejection of claims 15-17 is respectfully requested.

CLAIM 11: NO REJECTION PROVIDED

The Office Action did not provide a rejection of claim 11, which is not duplicative of any other claim. "When an examiner fails to mention a rejection in his final action, it has been dropped by the examiner and needs no further response by the applicant." Ex parte Martin, 104 USPQ 124, 128. Finally, 37 C.F.R. § 1.104(a)(2) states that "*The reasons for any adverse action* or any objection or requirement *will be stated in an Office action ...*"

The Examiner is respectfully requested to either provide a reason for the non-allowance of claim 11 or allow the same. Any future rejection of claim 11 must provide a basis for the same and must be non-final.

CLAIM 31

Claim 31 recites "the color value is such that, for different display systems, the emitted color of the color value tends to be perceived as being in a first general color category when emitted with a display system having a first value of the display characteristic, and the emitted color tends to be perceived as being in a second general color category when emitted with a display system having a second value of the display characteristic".

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Claim 31 was rejected as "similar to claim 29" and rejected with the same rational as claim 29. However, claim 29 does not recite the feature of claim 31 mentioned in the paragraph above. The rejection does not discuss this feature and rejects it without any basis. Each feature of a claim must be rejected based on prior art.

Applicant respectfully requests the Examiner to either withdraw the rejection of claim 31 or provide a citation to a prior art that teaches the unexamined feature of claim 31.

FURTHER REJECTION OF CLAIMS 11, 15-17, AND 31 MUST BE NON-FINAL

Claims 11 and 15-17 have not been amended, and the unexamined feature of claim 31 has not been amended. Applicant requests that either their rejection be withdrawn or a basis for rejecting their unexamined features be provided. Any such basis would be a new basis not necessitated by their amendment and must therefore be non-final.

As discussed above, the Office Action did not provide a basis for the rejection of various substantive features in claims 11, 15-17, and 31. The PTO Rules, at 37 C.F.R. § 1.104(a)(2), state that "*[t]he reasons for any adverse action* or any objection or requirement *will be stated in an Office action.*" As noted in MPEP § 706.02(j), when making an obviousness rejection, "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply". This is supported by case law. For example, as stated in In re Oetiker, 24 USPQ 2d 1443, 1447, "examiners ... must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument." In doing so, the Examiner is to set forth "the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate" (MPEP § 706.02(j)).

In sum, the Office Action does not provide any support for rejection of various features in claims 11, 15-17, and 31. Applicant therefore cannot respond to their rejection and is not being afforded a fair opportunity to reply. See also the rejection of claim 7 and 8, which were rejected based only on McLaughlin, which the Examiner explicitly acknowledged as lacking a color name input.

CLAIM 18

The rejection of claim 18 states that "Winter does not explicitly disclose '...patches displayed with a color of the specified color name of a color perception category'". The rejection refers to Stokes. However, as discussed above, Stokes does not display any colors at all. It is an algorithm for calculating a color gamut map. No display or user input is called for or necessary.

The rejection is also traversed because no motive is provided from the prior art. There is no discussion of how or why adding color perception categories to Winter would be beneficial or desirable or would improve Winter's color patch matching.

Withdrawal of the rejection is respectfully requested.

PRIOR ART COMBINATION NOT ENABLING

The rejection is further traversed because the combination of McLaughlin with Stokes does not disclose how to "automatically determin[e] a value approximating the display characteristic of said display unit in accordance with the color value of the color chart signal outputted from said signal output unit and in accordance with the interactive input entered through said input unit", where the interactive input identifies or selects a color perception category (e.g. claim 1).

The present specification sets forth specific techniques that may be used to automatically determine a characteristic or profile of a display unit using an inputted color perception category (see at least Figure 11). To "determine" can be "to find out or come to a decision about by investigation, reasoning, or calculation <determine the answer to the problem> <determine a position at sea>" (Merriam Webster). The prior art provides no teaching or information on how one would use a color categorization of a displayed color, or a selected or inputted color perception category to automatically find out or come to a decision about a display characteristic, profile, etc.

McLaughlin only mentions correcting a display parameter (by a colorimeter measurement) or a user inputting a specific display parameter. This does not enable one skilled in the art to determine a display characteristic, for example, from a user identified color

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perception category or other color categorization.

A reference which does not tell how to make or carry out a thing does not support a holding of anticipation unless "a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention; such a reference does not support holding of obviousness unless there is some known or obvious way to make the thing or to carry out the process" (see, In re LeGrice, 133 U.S.P.Q. (BNA) 365, 372 (1962), and In re Collins, 174 U.S.P.Q. 333 (CCPA 1972).

The enabling disclosure requirement may be stated as follows: to be anticipatory of a claimed invention, a reference (1) must contain sufficient technical information to enable a person of ordinary skill in the art to which the claimed invention pertains to make and use the claimed subject matter, without having to perform extensive experimentation or make an unobvious contribution. The requirements for 'enabling disclosure'... apply equally to references whether they are applied under 35 U.S.C. §102 or 35 U.S.C. §103. Furthermore, to be enabling, the prior art "must put the public 'in possession' of the subject matter (citing In re Brown, 329 F.2d 1006, 141 U.S.P.Q. 245 (CCPA 1964). See also, In re Wilder, 429 F.2d 447, 166 U.S.P.Q. 545 (CCPA 1970).

Applicant respectfully requests the Examiner either withdraw the rejection or to point out where the prior art provides sufficient information to allow one skilled in the art to actually build or perform the presently claimed invention, including at least how one with the cited teachings would have automatically determined a display characteristic or profile from a user categorizing a displayed color, inputting a color name, selecting or identifying a color perception category, etc.

DEPENDENT CLAIMS

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 12 recites "a profile producing unit for generating data representative of display characteristics determined by said display characteristics identification unit in a predetermined format to produce a profile representative of

characteristics as to display of an image by said display unit including the data". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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